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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,545	02/27/2004	Steven W. Ek	ART 03.03	9474
7590 03/29/2012 Grossman, Tucker, Perreault & Pfleger, PLLC 55 South Commercial Street Manchester, NH 03101				
EXAMINER COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/29/2012		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/789,545

**Applicant(s)**

EK, STEVEN W.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1, 3, 6 and 22-32 is/are pending in the application.
- 5a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1, 3, 6 and 33-39 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 21 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-SB08)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/21/10, 8/18/10, 9/13/10, 10/27/10, 12/13/10, 1/20/11, 2/25/11, 5/5/11, 8/10/11, 10/5/11, 12/1/11, 2/17/12, and 3/22/12

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 April 2010 has been entered.

### ***Election/Restrictions***

Applicant's confirmation of the election without traverse of invention I, claims 1-21, in the reply filed on 04 October 2007 is acknowledged. Claims 22-32 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden (6,299,645; of record).

Ogden teaches an implant 400 comprising: a load bearing surface, said surface comprising a body portion comprising a recess 408 comprising an undercut 406 and an insert 500 at least partially disposed in said recess 408 and comprising a protrusion 505 at least partially received in said undercut 406; further comprising a mounting feature 410; wherein said body portion comprises a metallic material (lines 2-3 of column 5) and said insert 500 comprises a polymeric material (lines 32-33 of column 6). A portion of the implant can be characterized as a tapered mounting post. Ogden does not explicitly teach using a hydrogel material such a polyvinyl alcohol gel or a polyhydroxyl-ethyl methacrylate gel; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the insert of such a hydrogel material, e.g. to mimic the properties of natural tissue, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 1, 6, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde et al. (US 6,599,321).

Hyde et al. teach one embodiment of an implant comprising: an implant body portion 424' comprising at least one annular recess; and an annular insert 402B' disposed in said recess; said implant comprising a load bearing surface, said load bearing surface comprising a portion of said body portion 424' and a portion of said insert 402B'; wherein said body portion 424' comprises a metallic body. Hyde et al. also teach another embodiment of an implant comprising an implant body portion 302 in a ring configuration comprising a plurality of recesses or slots 306; and a plurality of inserts 18

disposed in said recesses 306. Hyde et al. do not explicitly recite using a hydrogel material; however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the device to comprise a hydrogel material, e.g. to mimic the properties of natural tissue, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments filed 05 April 2010 have been fully considered but they are moot in view of the new grounds of rejection. In addition, the prior art remains capable of satisfying the claimed intended use. It is noted that statements of intended use and other functional statements do not impose any structural limitations on the claims distinguishable over the applied art, which is capable of being used as claimed if one so desires. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The examiner can normally be reached Monday-Friday, 9 a.m. - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, SPE, at (571) 272-4719***. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

***If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to***

TC3700\_Workgroup\_D\_Inquiries@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Comstock/  
Examiner, Art Unit 3733  
/EDUARDO C. ROBERT/  
Supervisory Patent Examiner, Art Unit 3733